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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/312,811	05/17/1999	MICHAEL A. GIARDELLO	PM-0261607	3077

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EXAMINER

TESKIN, FRED M

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/06/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/312,811

Applicant(s)
Giardello, et al.

Examiner
Fred Teskin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 24, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 18-20, 22, 23, and 25-34 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-8, 18-20, 25, 26, and 30-33 is/are rejected.
- 7) ☒ Claim(s) 3-5, 22, 23, and 27-29 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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1. Amendments presented in the Response of September 24, 2001 are acknowledged. The prior art rejection based on Minchak and Grubbs et al has been reconsidered and is withdrawn primarily in view of applicants' argument that Minchak states that the polydimethylsiloxane used in its examples functioned to protect the surface of the plaques that were produced. The previously indicated allowability of claims 7 and 8 also is withdrawn in view of the newly submitted prior art to Setiabudi et al, applied *infra*.

2. The search for the elected species of polyolefin and modifier has been extended to cover nonelected species embraced by the generic claims, as per MPEP 803.02. Accordingly, the election requirement is withdrawn as to the encompassed species and applicants are advised that if any claim(s) depending from or otherwise including all the limitations of any generic claim herein be presented in a continuation or divisional application, such claims may be subject to provisional and/or statutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 170 USPQ 129, 131-132 (CCPA 1971). See also MPEP § 804.01.

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3. The disclosure is objected to because of the following informalities: The specification at pages 1 and 4 refers to various PCT Publications and U.S. provisional patent applications, the disclosures of which are said to be "incorporated herein by reference". Applicants are reminded that incorporation by reference of essential material is proper only for U.S. patents and allowed applications, MPEP 608.01(p)(B), and are requested to clarify whether material disclosed in said publications and provisional applications is essential to the instant claims within the meaning of § 112, 1st paragraph. If so, such material should be added by amendment directly into the text of the specification. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following

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is required: the lack of proper antecedent basis for the subject matter of the terminology "cycloolefin" and "substituted ... dicyclopentadiene," as recited in new claim 25 and claims 26, 33 and 34, respectively.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 6-8, 18-20, 25, 26 and 30-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Setaibudi et al 6100323 ("Setaibudi").

Applicants' claims are drawn to a composition and article comprising a polyolefin prepared by the metathesis of an olefin monomer using a Ru or Os carbene catalyst; and one or more toughness and/or hardness modulators; and to a process for preparing a composition having toughness or hardness properties

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comprising contacting a cycloolefin with a Ru or Os carbene catalyst and one or more toughness and/or hardness modulators.

According to the present specification, the toughness and/or hardness modulators include rubber or elastomeric additives (page 4, ll. 26+).

Setaibudi discloses compositions comprising (a) a Diels-Alder adduct of cyclopentadiene (e.g., DCPD), (b) a catalyst for ring-opening metathesis polymerization, and (c) a defined weight percentage of a filler containing at least 0.5 % by weight of a basic adsorbent, based on the entire composition. The specifically disclosed compositions differ from applicants' only in that the combination of a Ru or Os carbene catalyst and a toughness and/or hardness modulator are not present in a single embodiment.

Nevertheless, Setaibudi, in describing component (b), generally teaches the alternativeness between Ru(+II) or Os (+II) complex salts and metal carbene complexes (col. 4, ll. 33-35 and 41-66), and identifies Ru carbene complexes of formula II (col. 5, ll. 1-10) as a preferred subclass of the latter. Thus, although only a single Ru(+II) complex salt is employed in Setaibudi's working examples, one of ordinary skill would have been led to utilize a Ru carbene complex as component (b) of the Setaibudi composition, given the indicated equivalency of the two complexes as ring-opening metathesis polymerization catalyst.

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As to the requisite toughness and/or hardness modulator, Setaibudi contemplates the presence of tougheners in the curable mixtures used to prepare the disclosed composition. In this context, mention is made of "core/shell polymers or the elastomers or elastomer-containing graft polymers known to the skilled person as rubber tougheners" (col. 6, ll. 10-15). Thus, where a composition displaying toughness properties is of interest, it would have been obvious to one of ordinary skill in the art to modify the curable mixture of Setaibudi by including a rubber toughener, such as an elastomer, together with a Ru carbene complex and the aforementioned components (a) and (c).

As to those dependent claims specifying weight percent ranges for the toughness modulator (i.e., claims 6-8 and 30-32), one of ordinary skill in the art would have perceived that the degree of toughness imparted to the ultimate composition is determined largely by the amount and kind of rubber toughener added to the curable mixture of Setaibudi. Thus, for a given toughener, it is apparent that routine tests must be conducted to ascertain the optimum amount needed to achieve a prescribed enhancement in toughness. The mere discovery of optimum ranges for a particular application is not deemed inventive, where, as here, the general direction is disclosed by the prior art and the particular ranges as claimed do not appear to produce a new and unexpected result

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vis-a-vis the results of the prior art. *Cf., In re Irmischer*, 66 USPQ 314; *In re Swain et al*, 70 USPQ 412.

7. Claim 34 is allowable over the prior art of record. Claims 3-5, 22, 23 and 27-29 are objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim.

8. Applicants' arguments filed September 24, 2001, have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

9. This action is made non-final.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The appropriate fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 and (703) 305-5433.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



FRED TESKIN
PRIMARY EXAMINER

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FMTeskin/01-26-02